Remarks

In response to the Office Action dated December 15, 2006, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 8-9 are rejected under 35 USC §102(e) as being anticipated by McDowell (US Pat. App. 20020035605). Claims 1-2 and 4-13 are rejected under §103(a) as being unpatentable over McDowell in view of Doss (US 20020188620).

Interview Summary

A telephonic interview between Applicants' representative, Arno Naeckel (#56,114), and the Examiner was held on January 11, 2007 to discuss the Examiner's rejections. During the interview, it was discussed whether the WAP browser running on the personal computing device of McDowell is being considered by the Examiner as a WAP IM application as well or whether the Examiner was asserting that the communication device was running both a Browser and an WAP IM Application. The Examiner clarified that it was his reading of McDowell that the communication device was running both applications. Further, it was discussed that an amendment to the claims regarding operations within a private network may overcome the current rejections.

102 Rejections

In the Office Action, claims 8 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by McDowell. Amended independent claim 8 recites in pertinent part:

"[a] method of receiving data sent from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network… comprising…receiving data from **a messaging application running on the first computing device** over a wireless digital packet-switched network…".

To anticipate, a reference must describe each and every element of the claims. MPEP 2131. Applicants respectfully assert that McDowell fails to describe a "messaging application running on the first computing device".

On page 2, the Office Action expressly equates the wireless subscriber device **210,** WAP Gateway **136** and **IM Server** of McDowell (See Fig. 2) to the first computing device, protocol server and instant messaging server, respectively, as recited in independent claim 8. Applicants respectfully continue to assert that McDowell describes that a WAP browser is running on the first computing device and that McDowell does not describe a messaging application running on the first computing device.

In support of this distinction, Applicants respectfully point out that McDowell describes that the wireless subscriber instant messaging capability is provided through a WAP client or a two-way SMS web page which is *resident on the IM Server*, that the subscriber (i.e. the subscriber device **210**) goes to a web page operated by her wireless carrier and that the *WAP IM client* allows subscribers to carry on all of the IM activities" (Para. 0092). It is further described that the *WAP client* is accessible via a standard web browser and that the *WAP client* provides full IM capabilities (Para. 0097). It is further described that the *WAP client* is accessible via a standard web browser and that the *WAP client* provides full IM capabilities (Para. 0097). Therefore, the subscriber device **210** is not itself running an IM application.

In paragraph 98, it is further described that a wireless subscriber **210** can access a number of IM clients including a *WAP client*. Therefore, if the wireless subscriber **210** communicates with the *WAP client* and a *WAP client* provides the IM capabilities then subscriber communication device **210** is not providing IM capabilities. McDowell is, therefore, not describing a messaging application running on the first computing device. McDowell is describing that the IM application is running on the WAP client located on the IM server or elsewhere.

Further, McDowell expressly and impliedly concedes that subscriber wireless device **210** does not run an embedded IM or buddy list application. McDowell recites that "[i]n the **future**, WAP and SMS **may** give way to…embedded IM and buddy lists in client wireless devices themselves". (Para. 0095). As such, McDowell is expressly confirming that embedded wireless instant messaging applications did not exist in subscriber wireless device **210** at the time of McDowell's filing and was merely speculating on future developments. Therefore, McDowell can not be describing a messaging application running on the first computing device because McDowell states that such an arrangement did not exist at the time of the filing of McDowell.

Therefore, when McDowell describes that the IM server allows wireless networks to send and receive instant messages from common IM platforms (Para. 46), McDowell is NOT describing or implying that subscriber wireless device **210** is sending and receiving instant messages since McDowell concedes that it can not do so. (Para. 0095). McDowell is describing that the subscriber wireless device **210** is accessing the IM server whereby a web page of the IM server is manipulated by the wireless device **210** to compose and read a message. (Para. 0092). Therefore, McDowell fails to describe a "messaging application running on the first computing device over the wireless digital packet-switched network" as recited in independent claim 8.

The Examiner points to Table 1, paragraph 50 and paragraph 59 of McDowell as describing conclusively that the subscriber wireless device **210** includes a messaging application. Applicants respectfully disagree.

Table 1 shows a wireless device status entry of "ON-WAP" which indicates that the "Phone is on and subscriber is using the WAP instant messaging application". (See, Table 1 Interpretation). However, it requires a leap in logic to get from "using a WAP instant messaging application" which is running on an IM Server via a web browser to describing that the wireless device includes "a messaging application running on the first computing device".

Paragraph 0059 describes that the PLIM (i.e. the IM server) retrieves online presence from various IM servers and makes it available to wireless subscribers on the WAP IM client. As discussed above the wireless device **210** is not the WAP IM client. The wireless device is merely looking at a web page executing on the WAP IM client (i.e. the IM Server).

Paragraph 0050 describes that the Presence Server **112** determines if a wireless device is on or off and that software on the handset can indicate whether the buddies are on or off. Software indicating that a buddy is on or off that is provided by a Presence Server is not describing that the wireless device includes "a messaging application running on the first computing device". Further, paragraph 0095 states that buddy lists capability embedded in the hand set does not yet exist but may in the future.

Furthermore, for prior art to anticipate within the context of §102, the prior art must contain enabling disclosure of the asserted subject matter. The mere naming or description of the subject matter is insufficient if it can not be produced without undue experimentation. MPEP 2121.01. Since McDowell expressly describes that the technology for wireless IM capability or for embedded IM/buddy lists in wireless devices did not exist in the art at the time of its filing

(para. 0095), its mere mention is not enabling in this respect. Therefore, McDowell is not §102 prior art for the proposition that McDowell describes that the wireless device includes "a messaging application running on the first computing device".

For at least the above reasons, McDowell fails to describe a messaging application running on the first computing device. Since McDowell fails to describe all of the claim elements, independent claim 8 is allowable over McDowell. Dependent claim 9 depends from an allowable independent claim 8 and is allowable for at least the same reasons.

103 Rejections

Claims 1-2 and 4-13 stand rejected as being unpatentable under McDowell in view of Doss. In its rejection, the Office Action asserts that McDowell teaches or suggests most of the claim elements. However, it is respectfully submitted that neither McDowell nor Doss, alone or in combination describes each and every element recited in amended independent claims 1, 7 and 10.

Claims 1-2, 4-6, 7 and 12

Independent claims 1 and 7 recite similar elements. As a representative example, independent claim 1 recites in pertinent part:

"[a] method of sending data from a first computing device to at least one of a plurality of second computing devices over a wireless digital packet-switched network, the method comprising:

initiating a first application on a first computing device…first application for accessing and retrieving legacy data…

initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device to an instant messaging server via the protocol server over a wireless digital packet-switched network;

generating data to be sent from the first computing device to the at least one of the plurality of second computing devices, wherein data is generatable …from the second application as an instant message…"

For the reasons discussed above in regards to the §102 rejections, McDowell does not describe "initiating a second application on the first computing device, the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device…wherein data is generatable …from the second application **as an instant**

message…". Therefore, since McDowell fails to describe initiating a second application on the first computing device, providing an instant messaging service…wherein data is generatable from the second application **as an instant message**, McDowell fails to describe the subject matter for which McDowell was asserted. Doss is directed to a dynamically enhanced database search comprising a static database and a dynamic database. As Doss does not address the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell. Therefore, independent claim 1 is allowable over the combination of McDowell and Doss for at least these reasons.

In the interest of an efficient prosecution, the Applicant respectfully asserts that amended independent claim 1 recites additional claim elements that are not disclosed in McDowell, Doss or their combination. Specifically amended independent claim 1 recites that the remote system and a plurality of second devices are "within a private network".

In making its rejection, the Office Action equates URL **220** (Fig. 2) to the remote system and equates the subscribers **731** and **733** (Fig. 7) to the plurality of second computing devices receiving IM messages as recited in amended independent claim 1. The Office Action continues by asserting that the wireless device **210** communicates with URL **220** via a web browser over WAP network **201, 205, 202, 207** and also with IM subscribers **731** and **733** (via WAP Gateway **136**, Wireless network **712**, PLIM **714** and internet **700**). Applicants respectfully point out that each of URL **220** and IM subscribers **731** and **733** are all accessed via public networks such as internet **700** and WAP network **205, 202, 201, 201.** Neither McDowell nor Doss describes the "first application for accessing and retrieving legacy data from a remote system within a private network via a protocol server… the second application providing an instant messaging service and enabling instant messaging data to be sent from the first computing device to a instant messaging server within the private network via the protocol server …wherein the instant message is delivered to the instant messaging server for further delivery to the at least one of the plurality of second computing devices within the private network without transmitting the instant message through the protocol server". Since neither McDowell nor Doss describes a wireless communication device both accessing a remote device to retrieve legacy data and also communicating with IM clients, all within a private network, amended independent claim 1 is allowable over the combination of McDowell and Doss for at least this reason.

Amended independent claim 7 contains similar recitations and is, therefore, allowable over the combination of McDowell and Doss for at least the same reasons. Dependent claims 2, 4-6 and 11-12 depend from an allowable independent claim 1 or 7 and are allowable for at least the same reasons.

Claims 10 and 13

In regards to claims 10, amended independent claim 10 recites, in pertinent part:

"[a] system for sending data over a wireless digital packet-switched network from a first computing device to at least one of a plurality of second computing devices…comprising…:
the first computing device implementing …an instant message application that generates instant messages…and wherein the protocol server …receives the instant messages and forwards them to the instant messaging server for delivery…".

For the reasons discussed above in regards to the §102 rejections, McDowell is not describing the first computing device implementing …**an instant message application that generates instant messages**…and wherein **the protocol server** …**receives the instant messages** and forwards them to the instant messaging server for delivery. McDowell merely accesses an IM web page via a WAP browser. The IM server hosting the web page then generates the instant messages. The first communication device is not implementing an instant messaging application wherein the protocol server is receiving the instant message. The instant message is being generated on the IM server which is on the back side of the protocol server. Therefore, McDowell fails to describe the subject matter for which McDowell was asserted. As Doss does not discuss the use of an IM application on a wireless device, Doss fails to cure this particular deficiency of McDowell.

Further, amended independent claim 10 recites "a computer system comprising a plurality of second computing devices within a private network, the plurality of second computing devices comprising a protocol server, remote system containing legacy data, and an instant messaging server". Therefore, for similar reasons discussed above in regards to this language as included in amended independent claim 1, amended independent claim 10 is allowable over the combination of McDowell and Doss for at least the same reasons.

Therefore, Applicants respectfully assert that the combination of McDowell and Doss fails to describe all of the claim elements of amended independent claim 10 and amended

independent claim 10 is allowable over the combination of McDowell and Doss. Claim 13 depends from an allowable independent claim 10 and is allowable for at least the same reasons.

Conclusion

In view of the foregoing amendments and remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicants' attorney at the number listed below.

At this time, no fees are believed due beyond the fee for an RCE. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025

Respectfully submitted,

Date: April 9, 2007

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